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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/316,805	05/21/1999	JOHN RAITHEL HIND	CR9-99-033	8335

25259 7590 09/29/2003

IBM CORPORATION
3039 CORNWALLIS RD.
DEPT. T81 / B503, PO BOX 12195
REASEARCH TRIANGLE PARK, NC 27709

EXAMINER

SONG, HOSUK

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 09/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

24

Office Action Summary

Application No.

09/316,805

Applicant(s)

HIND ET AL.

Examiner

Hosuk Song

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Traw et al.(US 5,949,877) in view of Traw et al.(US 6,542,610).

Claims 1,2: Traw disclose exchanging device certificates of first and second device in (col.7,lines 7-13,37-43). Device certificate having a unique hardware id is disclosed by Traw in (col.7,lines 28-30). Traw disclose cryptographically verifying the received certificate using the public key of Certificate Authority and exchanging challenges created by each of first and second devices in (col.7,lines 25-31, 44-60). Traw disclose responding to respective challenges by signing received challenge,using the receiving device private key, private keys residing in the respective protected storage in each device and returning signed challenges in (col.7,lines 66-67;col.lines 1-17 and col.10,lines 40-50). Traw disclose cryptographically verifying that received challenge signature is of the challenge previously sent by receiving device and establishing a key agreement between first and second devices in (col.8,lines 11-17). Traw disclose establishing secure communications if all of prior verifying steps succeed in (col.8,lines 18-29).

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Traw does not specifically disclose negotiating a two-way session encryption and mutual authentication requirements between first and second device. Traw patent disclose establishing initial session between first and second device and negotiating two way session encryption and mutual authentication requirements between two devices in (fig.2 and col.7,lines 6-25). It would have been obvious to person of ordinary skill in the art at the time invention was made to have pre- authenticated process as taught in Traw with device certificate method disclosed in Traw because secure communication can be achieved before actual delivery of secure contents thus adding security of its content. Further, it provides an assurance to each entity as to origin of its data sources and how data is routed to the destination thereby minimizing data compromise.

Claim 3: Traw disclose first established session is an authenticated connection in (col.8,lines 21-26).

Claim 4: Traw disclose first established session is an encrypted connection in (col.3,lines 49-52).

Claim 5: Traw disclose unique hardware identifier is a machine address in (col.10,lines 40-50).

Claims 6,7:examiner takes Official notice that write-only storage,read-write storage to store or perform computation is well known in the art. For example (EEPROM,DRAM,etc). Write only EEPROM can be used to store keys and can be written into the memory by the encryption circuitry, but he key can not be read from any other external leads connected to the chip thus providing full protection of its key against outside attacks. One of ordinary skill in the art would have been motivated to use these storage because it offers protection and data can be readily retrieved and access at user's discretion.

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Claim 8: Traw disclose public key of a CA is a public key of a root CA in (col.10,lines 40-46).

Claims 9-16 differs from claims 1-8 in that computer program code is claimed. It is inherent in system of Traw to include a software code in order to perform cryptographic processing. The examiner asserts that performing a cryptographic functions by a computer without implementation of software is not possible.

Claims 17,18: Traw disclose exchanging device certificates of first and second device in (col.7,lines 7-13,37-43). Device certificate having a unique hardware id is disclosed by Traw in (col.7,lines 28-30). Traw disclose cryptographically verifying the received certificate using the public key of Certificate Authority and exchanging challenges created by each of first and second devices in (col.7,lines 25-31, 44-60). Traw disclose responding to respective challenges by signing received challenge,using the receiving device private key, private keys residing in the respective protected storage in each device and returning signed challenges in (col.7,lines 66-67;col.lines 1-17 and col.10,lines 40-50). Traw disclose cryptographically verifying that received challenge signature is of the challenge previously sent by receiving device and establishing a key agreement between first and second devices in (col.8,lines 11-17). Traw disclose establishing secure communications if all of prior verifying steps succeed in (col.8,lines 18-29). Traw does not specifically disclose negotiating a two-way session encryption and mutual authentication requirements between first and second device. Traw patent disclose establishing initial session between first and second device and negotiating two way session encryption and mutual authentication requirements between two devices in (fig.2 and col.7,lines 6-25). It would have been obvious to person of ordinary skill in the art at the time invention was made to have

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pre- authenticated process as taught in Traw with device certificate method disclosed in Traw because secure communication can be achieved before actual delivery of secure contents thus adding security of its content. Further, it provides assurance to each entity as to origin of its data sources and how data is routed to the destination thereby minimizing data compromise.

Claim 19: Traw disclose first established session is an authenticated connection in (col.8,lines 21-26).

Claim 20: Traw disclose first established session is an encrypted connection in (col.3,lines 49-52).

Claim 21: Traw disclose unique hardware identifier is a machine address in (col.10,lines 40-50).

Claims 22,23: examiner takes Official notice that write-only storage,read-write storage to store or perform computation is well known in the art. For example (EEPROM,DRAM,etc). Write only EEPROM can be used to store keys and can be written into the memory by the encryption circuitry, but the key can not be read from any other external leads connected to the chip thus providing full protection of its key against outside attacks. One of ordinary skill in the art would have been motivated to use these storage because it offers protection and data can be readily retrieved and access at user's discretion.

Claim 24: Traw disclose public key of a CA is a public key of a root CA in (col.10,lines 40-46).

Response to Applicant's Arguments

3. Applicant states that "protected storage" is clearly defined in the specification where using a write-only storage means,such that there is no way for software residing in the device to

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read the key but the device can execute operations against the information. Applicant argues that neither of the Traw patents teach or suggest the use of protected storage as defined in the present invention. In response: Applicant is desirous of having the specification read into the claim language. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Applicant specifically claims "protected storage" where this limitation is fully met by Traw patent in (col.2, lines 53-60) which teaches anti-tampering measure to protect its keys. Applicant argues that specific types of protected storage are claimed in some of the dependent claims (e.g. write only storage of claim 6) in which Traw patent fails to teach or suggest. In response: Specific type of protected storage claimed in claim 6 by applicant is fully addressed by taking Official notice. Sufficient motivation and examples was provided in support of what is well known in the art.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

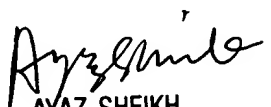
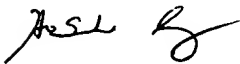
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5 Any inquiry concerning this communication should be directed to Hosuk Song whose telephone number is (703)305-0042. The examiner can normally be reached on Tues-Fri from 6:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh, can be reached on (703)305-9648.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.



AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100